REMARKS

35 U.S.C. §102

The Office Action rejected claims 1, 3-5, 7-12, 16-22, 24, and 28 under 35 U.S.C. §102(e), as being anticipated by either Sharkey et al.- 6,073,051 ('051) or Ashley et al. - 6,258,086 ('086). Applicant disagrees.

Claim 1 recites, in part, a method of using an electrosurgical system for treatment of a contained herniation of an intervertebral disc of a patient, the method comprising: guiding the shaft distal end within the intervertebral disc such that the at least one active electrode is in the vicinity of the contained herniation; and applying a high frequency voltage between the at least one active electrode and at least one return electrode, wherein at least a portion of tissue in the vicinity of the contained herniation is ablated.

Claim 18 recites, in part, a method of ablating tissue at a target site of an intervertebral disc having a contained herniation, the method comprising: advancing an introducer needle towards the intervertebral disc; passing a shaft distal end portion distally through a lumen of the introducer needle towards the disc, wherein the shaft distal end portion is positioned in the vicinity of the contained herniation; and applying a high frequency voltage between the at least one active electrode and at least one return electrode, the high frequency voltage selected for ablating disc tissue at the target site.

The limitations of claims 1 and 18 and all claims dependent therefrom are not taught by either the '051 or '086 patent.

The '051 patent to Sharkey et al., as cited by the Office Action, teaches application of heat to shrink the collagen component of the annulus fibrosus to tighten the annulus fibrosus. The '051 patent clearly teaches, on col. 20, lines 59-65, that energy delivered to the disc does not remove and/or vaporize disc material. Furthermore, at col. 4, lines 2-3, the '051 patent teaches application of RF energy to tissue without vaporizing the tissue. In contrast, applicant's claim clearly requires ablation of tissue. Clearly, applicant's claims are not anticipated by the '051 patent.

Also, there is no teaching or suggestion in the '051 patent regarding guiding the device to the vicinity of the contained herniation. Instead, the '051 patent does not teach or suggest where the treatment is to be applied relative to any herniation. The '051 patent only appears to teach providing RF energy along the inner wall of the annulus without specifying further.

Furthermore, in the section cited by the Office Action, the '051 patent states that electromagnetic energy is used to ablate *granulation* tissue which is pain sensitive and forms in the annulus fibrosus. Yet, there is still no teaching or suggestion that the at least one active electrode is in the vicinity of the contained herniation nor that a portion of tissue in the vicinity of the contained herniation is ablated.

The '086 patent to Ashley, as cited by the Office Action, teaches that degenerative discs with tears or fissures are treated non-destructively without the removal of disc tissue other than limited ablation to the nucleus. However, applicant is unable to find any teaching or suggestion in the '086 patent regarding placing at least one active electrode in the vicinity of the contained herniation and where at least a portion of tissue in the vicinity of the contained herniation is ablated. The '086 patent only appears to teach providing RF energy along the inner wall of the annulus without specifying further.

As discussed above, the '051 and '086 patents fail to recite all of the requirements of applicant's claims. Accordingly, applicant respectfully requests withdrawal of this rejection.

35 U.S.C. §103

The Office Action rejected claim 23 under 35 U.S.C. §103(a), as being unpatentable over either by either Sharkey et al. - 6,073,051 ('051) or Ashley et al. - 6,258,086 ('086). Applicant disagrees.

First, applicant notes that both the '051 and '086 patent fail to anticipate claim 18 from which claim 23 ultimately depends. Accordingly, on this basis alone the rejection should be withdrawn.

Second, applicant notes that throughout the specification (see e.g., pages 40-46) the particular voltage has an effect upon whether ablation or coagulation takes place with

the device. As taught in the specification, these settings determine the heat transmitted through the tissue. Accordingly, such values would not have been obvious with respect to applicant's claimed methodology.

In view of the above, applicant respectfully requests withdrawal of this rejection.

Allowable Subject Matter

Applicant's attorney wishes to express gratitude to the Examiner for the indication that claims 2, 6, 13-15, and 25-27 would be allowable if re-written in independent form including all limitations of the base and intervening claims.

SUMMARY

Applicant believes all outstanding issue raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,

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